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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,384	11/08/2001	Gregory Wright	215760US28	5139

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EXAMINER

BRINICH, STEPHEN M

ART UNIT PAPER NUMBER

2624

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/986,384	Applicant(s) WRIGHT, GREGORY	
	Examiner Stephen M. Brinich	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date <u>11/08/01, 2/11/02</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
 Paper No(s)/Mail Date. ____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: ____.</p> |
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Art Unit: 2624

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, the term "the image forming machine" lacks proper antecedent basis.

In claim 6, line 4, and claim 12, line 3, the term "said image machine" lacks proper antecedent basis.

In claim 7, lines 3 & 5-6, the term "the image forming apparatus" lacks proper antecedent basis.

These terms appear to refer to the same element, and should be worded in a consistent manner to clarify this point.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 2624

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-7, & 9-12, insofar as they are understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Hitachi Koki Imaging Solutions, Inc. "The Internet Document Controller" (October 2000).

Re claims 1 & 7, The Internet Document Controller discloses a method and apparatus for monitoring a remote image forming device in which a remote location receives information representing an image forming device condition ("i-service: More Machine Uptime", page 4 - the described "remote diagnostics" inherently require the transmission of device condition information from the device to the site where the remote diagnosis occurs). This device condition information includes (page 4, middle right figure indicating the display at the remote location) a first parameter indicating a number of pages which, when exceeded, will trigger a display of a "maintenance warning" message and a second parameter indicating the number of pages printed by the device. The described "maintenance warning" message (to be triggered when the number of pages exceeds the indicated quantity) inherently requires that these two parameter values are compared and stored for at least long enough to carry out this comparison.

Art Unit: 2624

Re claims 3 & 9, The Internet Document Controller mentions ("*i-service: More Machine Uptime*", page 4) the running of a "diagnostic" (i.e. test) procedure is run on the remote image forming device. The above described operation of comparing a number of pages which, when exceeded, will trigger a display of a "maintenance warning" message and the number of pages printed by the device subsequent to such a diagnostic procedure would thus read on the claim requirement that the recited parameter is obtained after the remote image forming device is operated to execute a test operation.

Re claims 4-5 & 10-11, The Internet Document Controller discloses ("*i-service: More Machine Uptime*", page 4) the use of e-mail to communicate between the remote image forming device and the remote location that receives information representing an image forming device condition.

Re claims 6 & 12, The Internet Document Controller discloses ("*i-service: More Machine Uptime*", page 4) the performance of adjustments at the remote location to be transmitted to the remote image forming device resulting in a modification to the condition of the remote image forming device.

Art Unit: 2624

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 2 & 8, insofar as they are understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over The Internet Document Controller.

Re claims 2 & 8, The Internet Document Controller further discloses (page 4, middle right figure) a value (corresponding to the recited "tolerance") indicating a number of pages which, when exceeded, will trigger a display of a "maintenance needed" message (as distinguished from the previously described "maintenance warning" message). The described "maintenance needed" message (to be triggered when the number of pages exceeds the indicated quantity) inherently requires that the second parameter (number of pages printed) and the tolerance value (number of pages that will trigger the "maintenance needed" message) are compared and stored for at least long enough to carry out this comparison.

Art Unit: 2624

The Internet Document Controller does not describe a highlighted display of the "maintenance needed" message.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to highlight the "maintenance needed" message.

The suggestion/motivation for doing so would have been to distinguish this message from the (less immediately in need of attention) "maintenance warning" message.

Therefore, it would have been obvious to combine a standard message highlighted display with The Internet Document Controller to obtain the invention as specified in claims 2 & 8.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kravette et al, Weinberger et al (each), and Evanitsky et al disclose additional examples of remote monitoring of image forming devices.

8. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application or proceeding or any inquiry of a general nature concerning application processing should be directed to the Tech Center

Art Unit: 2624

2600 Customer Service center at 571-272-2600 or to the USPTO


Contact Center at 800-786-9199 or 703-308-4357.

The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300 (as of July 15, 2005).

Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.


Stephen M Brinich
Examiner
Art Unit 2624

smb
September 16, 2005